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APPLICATION NO.	FILING DATE	FIRST-NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/311,753	05/14/1999	TSUYOSHI INOUE	Q54370	1662

7590

11/30/2001

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EXAMINER

BERNATZ, KEVIN M

ART UNIT PAPER NUMBER

1773

DATE MAILED: 11/30/2001

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/311,753

Applicant(s)

INOUE ET AL.

Examiner

Kevin M Bernatz

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

1. Amendments to the specification and claims 2 and 3, filed on September 20, 2001, have been entered in the above-identified application.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 USC § 102

3. Claims 2 – 4 are rejected under 35 U.S.C. 102(b) as being anticipated by Groff (U.S. Patent No. 4,308,313).

The above rejection is maintained for the reasons of record as set forth in Paragraph No. 6 of the Office Action mailed on June 20, 2001 (Paper No. 13). With regard to the amended limitation regarding the structure, the examiner notes that Groff reads on the structure as claimed (col. 2, lines 60 – 67 and Example 3).

Claim Rejections - 35 USC § 103

4. Claims 2 – 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over E. P. Wenzelberger et al. (U.S. Patent No. 2,352,463) in view of Brown et al. (U.S. Patent No. 5,662,978).

The above rejection is maintained for the reasons of record as set forth in Paragraph No. 7 of the Office Action mailed on June 20, 2001 (Paper No. 13). With

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regard to the amended limitation regarding the structure, the examiner notes that E. P. Wenzelberger et al. reads on the structure as claimed (see rejection of record).

5. Claims 2 – 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mamish ('225) in view of Deeb et al. (U.S. Patent No. 6,042,882).

The above rejection is maintained for the reasons of record as set forth in Paragraph No. 8 of the Office Action mailed on June 20, 2001 (Paper No. 13). With regard to the amended limitation regarding the structure, the examiner notes that Deeb et al. reads on the structure as claimed (see rejection of record).

6. Claims 2 – 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shirai et al. (either U.S. Patent No. 6,037,054 or European Patent No. 839886 A2) in view of Brown et al. ('978) and further in view of Deeb et al. ('882).

The above rejection is maintained for the reasons of record as set forth in Paragraph No. 9 of the Office Action mailed on June 20, 2001 (Paper No. 13). With regard to the amended limitation regarding the structure, the examiner notes that Deeb et al. reads on the structure as claimed (see rejection of record).

Response to Arguments

7. **The rejection of claims 2 - 4 under 35 U.S.C § 102(b) - Groff**

Applicant(s) argue(s) that Groff fails to disclose the pressure sensitive adhesive on the surface of the polymer film. The examiner respectfully disagrees.

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Applicant(s) are reminded that the rejection is based on the entire reference(s) and not just a piece meal analysis of the cited reference(s). In the instant case, Groff clearly disclose embodiments wherein the adhesive is located on the polymer film opposed to the non-woven fabric (col. 2, lines 60 – 67 and Example 3).

Applicants further argue that Groff is non-analogous art. The examiner respectfully disagrees.

The examiner again reminds applicants that the limitation “for protecting paint films of automobiles” is an intended use limitation and is given little or no weight in determining patentability since it is not further limiting in so far as the structure of the product is concerned. See MPEP § 2111.02.

“The preamble is not given the effect of a limitation unless it breathes life and meaning into the claim. In order to limit the claim, the preamble must be “essential to point out the invention defined by the claim.” Kropa v. Robie, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951) (discussed below). In claims directed to articles and apparatus, any phraseology in the preamble that limits the structure of that article or apparatus must be given weight. In re Stencel, 828 F.2d 751, 4 USPQ2d 1071 (Fed. Cir. 1987) (discussed below). On the other hand, a preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. In re Hirao, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) (process claims, discussed below); Kropa v. Robie, 187 F.2d at 152, 88 USPQ at 481 (claims directed to apparatus, products, chemical structure, etc., as discussed below).”

Furthermore, the examiner notes that applicants' invention and the invention of Groff are both directed to adhesive tapes, where one of ordinary skill in the art would clearly know that adhesive tapes can be made to have a wide variety of applications (see Deeb et al., '882, col. 1, lines 23 – 41).

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8. The rejection of claims 2 - 4 under 35 U.S.C § 103(a) – E. P. Wenzelberger et al. in view of Brown et al.

Applicant(s) argue(s) that E. P. Wenzelberger et al. is non-analogous art. The examiner respectfully disagrees for the reasons above.

Applicants further argue that Brown et al. and E. P. Wenzelberger et al. are not combinable since they are non-analogous with each other. The examiner respectfully disagrees.

E. P. Wenzelberger et al. is directed to a non-woven fabric with an adhesive bonding layer. Brown et al. is directed to various improved non-woven fabrics for similar uses as E. P. Wenzelberger et al. (protective coverings, surgical applications, shielding for protection against painting, etc). As such, the examiner deems the combination is within the knowledge of one of ordinary skill in the art since improved non-woven fabrics are clearly required for improved adhesive tapes.

Applicants further question the calculation of the g/m^2 values from the osy values.

The examiner directs applicants to the disclosure of Brown et al. wherein they give the meanings of the terms osy and gsm (col. 1, lines 63 – 67 and col. 7, lines 21 – 23).

Finally, applicants argue that there is no motivation to combine the two references. The examiner respectfully disagrees.

As stated in the rejection of record, Brown et al. clearly disclose a benefit to using a non-woven backing meeting applicants' claimed limitations (col. 1, lines 33 – 43).

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9. The rejection of claims 2 - 4 under 35 U.S.C § 103(a) – Mamish in view of Deeb et al.

Applicant(s) argue(s) that Mamish is non-analogous art. The examiner respectfully disagrees for the reasons above.

Applicants further argue that Mamish does not provide any motivation to use a fabric having a basis weight recited in applicants' claims. The examiner respectfully disagrees.

As stated in *In re Wertheim*, 541 F.2d 257, 191 USPQ 90 (CCPA 1976), "the disclosure in the prior art of any value within a claimed range is an anticipation of that range." See also, *Titanium Metals Corporation of America*, 227 USPQ 773 (Fed. Cir. 1985), *In re Petering*, 301 F.2d 676, 133 USPQ 275 (CCPA 1962).

Applicants further argue that there is no motivation to combine the references. The examiner respectfully disagrees.

As clearly stated in the rejection of record, Deeb et al. teach the benefits of placing the pressure sensitive adhesive on the polymeric film instead of the non-woven fabric (col. 7, lines 34 – 47).

10. The rejection of claims 2 - 4 under 35 U.S.C § 103(a) – Shirai et al. in view of Brown et al. and Deeb et al.

Applicant(s) argue(s) that Shirai et al. fails to teach the pressure sensitive adhesive on the polymeric film instead of the non-woven fabric. The examiner agrees.

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Applicants are reminded that the test of obviousness is not express suggestion of the claimed invention in any or all references but rather what the references taken collectively would suggest to those of ordinary skill in the art presumed to be familiar with them. *In re Rosselet*, 347 F.2d 847, 146 USPQ 183 (CCPA 1965); *In re Hedges*, 783 F.2d 1038; *Ex parte Martin* 215 USPQ 543, 544 (PO BdPatApp 1981). In the instant case, Deeb et al. teach placing the pressure sensitive adhesive on the polymeric film instead of the non-woven fabric.

Finally applicants argue that the combined teachings requires "significant reconstruction of the prior art". The examiner respectfully disagrees.

As clearly stated in the rejection of record, each and every obvious modification has motivational support which is found in the prior art of record available to one of ordinary skill in the art at the time of applicants' invention. In addition, applicants are reminded that reliance on a large number of references in a rejection does not, without more, weigh against the obviousness of the claimed invention. See *In re Gorman*, 933 F.2d 982, 18 USPQ2d 1885 (Fed. Cir. 1991).

Conclusion

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

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mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kevin M Bernatz whose telephone number is (703) 308-1737. The examiner can normally be reached on M-F, 9:00 AM - 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul Thibodeau can be reached on (703) 308-2367. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-6078 for regular communications and (703) 305-3599 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0651.



KMB
November 16, 2001



STEVAN A. RESAN
PRIMARY EXAMINER